

REMARKS

In the Office action mailed May 2, 2006, the examiner rejects all the claims. The applicants respectfully request reconsideration in light of this reply.

I. Response to § 112 rejection

Claims 1, 4, 11, and 15 stand rejected under 35 U.S.C. §112, second paragraph, on the ground that these claims include limitations lacking antecedent basis. This reply responds to these rejections by amending the claims.

II. Claims 1, 3, 4, 6, 7, 9, and 11-16

Claims 1, 3, 4, 6, 7, and 9 stand rejected as anticipated by U.S. Patent Application Publication No. 2002/0026540 ("Smyers"). Additionally, claims 11-16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Smyers in view of U.S. Patent Application Publication No. 2001/0002480 ("Dekoning"). These rejections are respectfully traversed.

Claim 1 defines a method comprising determining a target storage controller where the determining comprises "searching a mapping table". Smyers does not disclose this limitation.

The examiner asserts that this limitation is inherent to the system of Smyers (see page 5, section 3, of the Office action). The applicants respectfully traverse this assertion.

The M.P.E.P. explains that to establish inherency, the missing matter must be "necessarily present" in the reference. M.P.E.P. § 2112(IV). Further "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *Id.* The M.P.E.P. also explains that "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Id.*

Smyers teaches a system where a controller sends a record instruction to a selected audio/video hard disk drive ("AVHDD"). The selected AVHDD then determines which of a group of AVHDDs should record content and sends a record instruction to the available AVHDD (see pars. 32 and 33). Additionally, Smyers explains that the system could use RAID techniques (see par. 47).

Searching a mapping table when determining a target storage controller is not inherent to these or any other functions of Smyers at least because one could implement these functions various ways. For example, a selected AVHDD could determine an available AVHDD by transmitting a message over the entire network to all components requesting responses from available AVHDDs. As one could implement the various functions described in Smyers without the above-cited limitation of claim 1, this limitation is not inherent to Smyers.

The examiner fails to reasonably support the inherency determination. The examiner incorrectly asserts that the above-cited feature of claim 1 is inherent to the RAID techniques of Smyers, paragraph 47. Additionally, the examiner asserts "[t]o determine a target storage, the mapping table is searched to locate a redundant disk that corresponds to the current target disk". Smyers does not teach such a feature, and the examiner does not provide any other support for this assertion. And as one could implement a RAID system in numerous ways, there is no reason to believe that the above-cited feature is "necessarily present" in the reference.

Regarding Dekoning, this reference is directed to a centralized cache for multiple data controllers. Nothing has been cited or found in Dekoning that is relevant to the above-cited feature of claim 1. As such, the combination of Smyers in view of Dekoning also does not teach this feature of claim 1.

As the cited prior art does not teach or suggest every feature of claim 1, the cited prior art does render claim 1 unpatentable. Claims 4, 7, 9, 11, and 15 are patentable at least because they each include a limitation comparable to the above-cited limitation of

claim 1. Claims 3, 5, 6, 12-14 and 16 are patentable at least because each depends from an allowable base claim.

Further regarding claim 1, claim 1 defines a method comprising a first one of a plurality of storage controllers forwarding an execution status to a host. Nowhere does Smyers teach this limitation.

As previously explained, Smyers teaches a system where a controller sends a record instruction to a selected audio/video hard disk drive ("AVHDD"), and the selected AVHDD then determines which of a group of available AVHDDs should record content. Additionally, Smyers explains that the available AVHDD informs a prior recording AVHDD that it is successfully recording a stream of data (see par. 35, ll. 1-4).

Although Smyers teaches informing a prior recording AVHDD of a successful recording, nowhere does Smyers teach informing either controller 80 or computer 20. No other portions of Smyers relate to this limitation of claim 1.

The examiner asserts that Smyers inherently includes the above-cited limitation of claim 1. Contrary to this assertion, there is no reason to believe that Smyers inherently possesses this limitation. Although the examiner appears to assert that computer 20 in figure 4 corresponds to the "host" of claim 1 (*see* p. 5, l. 7, of the Office action), as previously explained, nowhere does Smyers teach an AVHDD forwarding an execution status to computer 20. Further, the system of Smyers does not require an AVHDD to forward such information to computer 20. Instead, computer 20 could simply assume that all recording requests will be properly executed. Thus, this feature is not "necessarily present" in Smyth.

III. Claims 17 and 18

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Smyers in view of U.S. Patent No. 6,850,938 ("Sadjadi"). These rejections are respectfully traversed.

Claim 17 defines a method comprising determining whether a received access request corresponds to either a read or a write request to two or more storage elements. Smyers in view of Sadjadi does not teach or suggest this limitation.

Regarding Smyers, as previously explained, Smyers describes a system for recording audio/visual streams to hard drives. Nowhere does Smyers teach determining whether a single received access request corresponds to either a read or a write request to two or more storage elements.

Regarding Sadjadi, Sadjadi pertains to the situation where several processes attempt to access the same information in a database. Thus, not only does Sadjadi not pertain to an operation where a single request corresponds to either a read or a write request to two or more storage element, but Sadjadi addresses the opposite situation where two or more requests attempt to access a single storage element. As such, Sadjadi does not teach or suggest the above-cited limitation of claim 17.

As neither Smyers nor Sadjadi teaches or suggests determining whether a received access request corresponds to either a read or a write request to two or more storage element, the combination of Smyers and Sadjadi also does not teach or suggest this feature. As a result, these references do not render claim 17 unpatentable. Claim 18 is not unpatentable at least because it depends from claim 17.

IV. Conclusion

In view of the above amendment, the applicants believe the pending application is in condition for allowance. If there are any formal matters remaining after this reply, the applicants respectfully request the examiner to telephone the undersigned. If there

are any additional fees associated with the filing of this reply, including fees required under 35 C.F.R. §§ 1.16 or 1.17, please charge them to deposit account no. 04-1073.

Dated: July 31, 2006

Respectfully submitted,

By Stephen A. Soffen

Stephen A. Soffen

Registration No.: 31,063

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1825 Eye St NW

Washington, DC 20006-5403

(202) 420-2200

Attorneys for Applicant